

### **REMARKS**

Applicant appreciates the recognition of patentable subject matter in the present application. Applicant submits this RCE to have new art considered by the Examiner and the rejections reconsidered in view of at least the below positions of Applicant. Allowance of all claims is respectfully requested.

Applicant hereby adds new claims 133-136. Accordingly, claims 89-136 are pending in the present application.

Claims 98-107, 115-124, and 128-132 stand rejected under 35 U.S.C. 112, second paragraph. Claims 98-107, 115-124, and 128-132 stand rejected under 35 U.S.C. 112, first paragraph. Claims 115-117 and 119-123 stand rejected under 35 U.S.C. 102(b) for anticipation by U.S. Patent No. 5,670,066 to Barnes et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

With respect to the indefiniteness rejections, Applicant submits the rejected claims are definite and understood by one of ordinary skill in the art and Applicant respectfully requests reconsideration of the indefiniteness rejections for at least the below-mentioned reasons.

35 U.S.C. §112, second paragraph, requires that the claims particularly point out and distinctly claim the subject matter that **the patent applicant regards as their invention**. "Distinctly" has been interpreted to mean simply that the claim must have a clear and definite meaning when construed in the light of the complete patent document.

*Standard Oil Company v. American Cyanamid Company*, 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985). Further, the definiteness of the claim language employed must not be analyzed in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one of having ordinary skill in the pertinent art. Applicant submits such language is clearly understandable by one of skill in the art, and definite in light of and well supported by the originally filed specification. One skilled in the art would have no problem understanding the pending claims. Such claims are certainly definite when the specification and claims are read as a whole.

Applicant notes the requirements of MPEP '2173.04 and breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if Applicant has not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. Applicant requests withdrawal of the indefiniteness rejections.

Referring to the indefiniteness rejection of claim 98, it is alleged in the Action that it is unclear what the first and second workpiece represent. Applicant submits that the first and second workpieces correspond to two different workpieces. Applicant refers the Examiner to teachings of the originally-filed application to illustrate the definiteness of the claim. For example, page 7 introduces calibration workpieces and production workpieces. Page 16 of the specification proceeds to discuss in one possible embodiment receiving a calibration workpiece within an intermediate member and thereafter plural production

workpieces are individually placed within the intermediate member and processing of such workpieces occurs in mass. Accordingly, the recitation of first and second workpieces is clearly supported by the originally filed application. Further, a person of ordinary skill would understand and consider definite the plural first and second workpieces recited in claim 98. Fig. 1 clearly illustrates an electronic device workpiece as reference 20 and the teachings on page 16 clearly support an example embodiment of the individual placement and removal of different workpieces one after another and which would be considered definite by one of ordinary skill in the art. In one example, the first workpiece may refer to a production workpiece and the second workpiece may refer to a calibration workpiece. First and second workpieces of claim 98 may also refer to other plural workpieces such as plural production workpieces. It is clear that the originally-filed application supports different plural workpieces and one of ordinary skill in the art would understand the recitation of first and second workpieces in claim 98. Apart from the receiving of the first and the second workpieces within the apparatus and in accordance with Applicant's right to define the claims in terms he so chooses, claim 115 does not further explicitly recite a relationship or association of the workpieces and such is not required for definiteness. In view of the above, Applicant respectfully requests withdrawal of the indefiniteness rejection and allowance of claim 98.

With respect to claim 115, the Examiner again states it is allegedly unclear how the semiconductor device is interrelated and associated with the communicating step. In response, Applicant once again submits that the semiconductor device is not expressly

related or associated with the communicating step according to the explicit recitation of limitations of claim 115 and according to Applicant's right to claim the subject matter he regards as his invention. Accordingly, the alleged indefiniteness pertains to language not recited in claim 115. Nowhere does claim 115 explicitly recite any relationship or association of the semiconductor device with a communicating step so in no fair interpretation may such alleged unclarity be considered to render claim 115 indefinite. Claim 115 recites **communicating signals using the workpiece**. Applicant submits the communicating recitation of claim 115 is understood and definite to one of ordinary skill.

Further referring to claim 115, the Office says it is unclear how the semiconductor device is interrelated and associated with the workpiece. Applicant submits that inasmuch as claim 115 does not explicitly recite an interrelationship or association any alleged indefiniteness thereof is irrelevant to claim 115.

It is axiomatic that Applicant may define the invention in the claims in terms which **Applicant** regards as the invention. Applicant has done so in claim 115. The Office's assertion of alleged indefiniteness pertains to aspects not explicitly recited by Applicant. Applicant's claim 115 is clear, definite and understood by one of skill in the art especially when properly considered in view of the entire application teachings. Applicant respectfully requests a telephone call if the rejection of claim 115 is not withdrawn in an effort to further the prosecution of this application.

With respect to the statement on page 3 of the Action that it is necessary to understand the relationship of the semiconductor device and the communicating step and

the relationship between the workpiece and the semiconductor device in order to perform the concept of claim 115. Applicant disagrees for the above-mentioned reasons. Applicant has defined the invention in his chosen terms as they are free to do. Applicant has not recited a relationship or association and is not required to do so. The claimed terminology Applicant has presented by claim 115 is clear and understood by one of skill in the art and accordingly Applicant has met the requirement of 112, second paragraph. To require Applicant to further recite a relationship or association is contrary to Applicant's freedom to define his invention in his own terms. The language of claim 115 is clear and definite and Applicant requests the withdrawal of the indefiniteness rejection for at least this reason.

Referring to claims 130 and 132, once again, Applicant has defined the invention in terms which Applicant regards as the invention. Applicant has not claimed any relationship and association of respective ones of the calibration workpiece or the production workpiece and the semiconductor device, and Applicant is under no requirement to do so inasmuch as Applicant is free to define the invention in his chosen terms. Claims 130 and 132 are clear, definite and understood by one of skill in the art without defining a relationship or association of the calibration workpiece or production workpiece and the semiconductor device. The recited calibration workpiece, production workpiece and semiconductor device are clear and definite in the current language of claim 115 and accordingly Applicant has met the requirement of 112, second paragraph. Applicant requests withdrawal of the indefiniteness rejection of claims 130, 132 in the next

Action.

Referring to the 112, first paragraph rejection, Applicant respectfully requests reconsideration and withdrawal of the rejection. The above-identified teachings of the originally filed application including the specification and drawings clearly enable and support the language of claim 98 including the claimed receiving. Page 7 introduces calibration workpieces and production workpieces and page 16 of the specification proceeds to discuss in one possible embodiment receiving a calibration workpiece within the intermediate member and thereafter plural production workpieces are individually placed within the intermediate member and processing of such workpieces occurs in mass. Accordingly, the recitation of first and second workpieces is clearly supported by the originally filed application. Fig. 1 clearly illustrates an electronic device workpiece as reference 20 and the teachings on page 16 clearly support the individual placement and removal of *different workpieces* one after another combined with the teachings of Fig. 1. In one example, the first workpiece of claim 98 may refer to a production workpiece and the second workpiece may refer to a calibration workpiece in one embodiment. First and second workpieces of claim 98 may also refer to other plural workpieces. It is clear that the originally-filed application supports the claimed receiving of different plural workpieces (i.e., the claimed first and second workpieces) and one of ordinary skill in the art would understand the recitation of first and second workpieces in claim 98.

Further, Applicant submits that one of ordinary skill would consider claim 98 to be fully enabled by the originally-filed application. MPEP §2163.02 (8th Edition) states the test

for sufficiency of support in a application is whether the disclosure relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” MPEP §2163.02 (8th Edition) *citing Ralston Purina Co. v Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Notably, the subject matter of the claim need not be described literally (i.e., **using the same terms** or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP §2163.02 (8th Edition).

The Examiner is respectfully reminded that MPEP §2163 I. (8th Edition) states it is now well accepted that a satisfactory description may be in the claims or any other portion of the originally-filed specification and an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention (citations omitted).

The clear discussion of different workpieces in the originally filed specification (e.g., calibration and production workpieces, processing of plural production workpieces in mass per the specification) clearly support the limitations of claim 98 and show Applicant had possession of receiving first and second workpieces within a workpiece processing apparatus. Applicant respectfully requests withdrawal of the 112, first paragraph rejection of claim 98 and allowance of claim 98 in the next Action.

Applicant is unsure of the language of claims 115-124 and 129-132 rejected under 112, first paragraph. For example, the Action on page 2 in support of the 112, first

paragraph rejection identifies language which does not appear in any of claims 115-124 and 129-132. It is believed that the rejection of such claims is the result of typographical error and Applicant requests withdrawal of the enablement rejection of such claims in the next Action. If Applicant is mistaken with respect to this point, Applicant respectfully requests clarification of the rejection in a non-final Action so Applicant may appropriately respond.

With respect to the anticipation rejection over Barnes, Applicant demonstrated that numerous limitations of claim 115 are not shown nor suggested by the prior art in the previous Office Action response. Applicant respectfully stated that the rejection did not comply with the CFR inasmuch as numerous claimed limitations exist which are not shown nor suggested by the prior art and requested that the Office submit a new rejection which identified prior art teachings in support of the rejection. The Office has failed to cure the deficiencies of the prior Action in view of the failure to recite proper teachings in the present Action.

Initially, Applicant challenged the Office's reliance upon inherency in the previous Action because the allegedly inherent limitations of claim 115 do not necessarily flow from the teachings of Barnes as required for proper reliance upon inherency. The Examiner is reminded that, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).



There is absolutely no evidence of record that the wafer 32 of Barnes would inherently have circuitry at its bottom as baldly alleged on page 4 of the Action with absolutely no support being provided. In fact, the Office's reliance upon inherency is directly contrary to typical workpiece processing. More specifically, circuitry may be formed upon an upper, *exposed* surface of the workpiece not the unexposed bottom surface contacting and clamped to a support member of the apparatus as explicitly disclosed by Barnes. Barnes provides absolutely no teaching or suggestion of any circuitry on the bottom of the workpiece as alleged by the Office.

Barnes discloses chuck 30 establishing an electrostatic force to hold wafer 32 in place. *The mere utilization of an electrostatic clamping force provides absolutely no teaching or suggestion of the wafer having circuitry at its bottom nor coupling circuitry of the wafer with circuitry of the workpiece holder as claimed. The provision of the clamping force is applied regardless of the configuration of the wafer including circuitry or not including circuitry.* Accordingly, the application and generation of the clamping force is independent of wafer 32 having or not having circuitry. It follows that the allegedly inherent characteristics (i.e., the wafer having circuitry at its bottom) do not necessarily flow from the teachings of Barnes and claim 115 is allowable for at least this reason.

The reliance upon inherency to modify the Barnes reference teachings directly contrary to typical semiconductor processing techniques illustrates the tenuous position of the rejection of claim 115. The failure of the Office to identify any teachings of the prior art allegedly disclosing limitations of claim 115, despite Applicant's requests to comply with the

CFR, further underscores the improper nature of the prior art rejection of claim 115.

The application of the electrostatic force of Barnes fails to disclose or suggest any communication of signals intermediate wafer 32 and chuck 30. Assuming arguendo, even if Barnes were considered to disclose "circuitry at its bottom" as alleged, there is no *communication of signals intermediate the circuitry of the wafer and the circuitry of the workpiece holder* as claimed. Applicant notes the Office Action is devoid of identifying any teachings of Barnes which allegedly disclose or suggest the claimed communicating. The electrostatic clamping force fails to teach or suggest the claimed communicating. Applicant has electronically searched the complete Barnes reference and has failed to identify any communication teachings. The rejection of claim 115 is improper for numerous reasons including a flawed reliance upon inherency, and even if Barnes were to be interpreted as having circuitry on its bottom there is absolutely no teaching or suggestion of communication of signals using a workpiece (or any circuitry thereof) and which are received within a workpiece processing apparatus from the workpiece.

Accordingly, Barnes fails to disclose or suggest *communication of signals using a workpiece* provided within a workpiece processing apparatus as claimed. The clamping electrostatic force generated by the chuck of Barnes fails to disclose or suggest the claimed communicating. An electronic search of Barnes fails to uncover any communication teachings. The clamping force of Barnes also fails to disclose or suggest the receiving of signals within the apparatus *from the workpiece*. Numerous limitations of claim 115 are not shown nor suggested by the prior art and claim 115 is allowable for

at least this reason.

Applicant once again reminds the Office of the requirement to provide Office Actions which identify specific reference teachings relied upon by the Office in support of a rejection. Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a **non-final Action** if claim 115 is not found to be allowable.

In particular, the Action on page 4 states the circuitry of the wafer communicates with circuitry of the workpiece holder. Applicant disagrees and requests identification of specific Barnes teachings which disclose or suggest the communicating and receiving recited in claim 115. The provided clamping force of Barnes fails to provide any communication as clearly evidenced by the omission in Barnes of any teachings with respect to communications as verified by an electronic search.

Barnes is devoid of disclosing numerous limitations of Applicant's claims at least some of which have been identified above. The only source of the rejections may result from the personal knowledge of the Examiner. Applicant hereby requests identification of prior art which discloses claimed limitations not found in the references of record or the submission of an affidavit in support of any rejection of the claims in **a non-final Action**. "[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970).

The claims which depend from independent claim 115 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 123, it is baldly alleged on page 4 of the Action that it **appears** that the signals from the circuitry 34, 38 of the workpiece holder are information. Even if true, such teachings fail to disclose limitations of claim 123. First, Applicant notes that the claimed signals comprising information refer to ***signals communicated using the workpiece*** as recited in claim 115. Accordingly, the communication of signals from a *workpiece holder* is irrelevant to the limitations of claim 123 regarding communicating of signals using a workpiece and accordingly Barnes fails to disclose or suggest limitations of claim 123. In addition, in no fair interpretation may electrostatic forces used to clamp a wafer be considered to disclose or suggest signals comprising ***information*** as positively

claimed. Claim 123 is allowable for at least the above compelling reasons.

Referring to claim 124, Barnes is clearly devoid of any communication of signals comprising information let alone ***communicating signals comprising information regarding process conditions of the apparatus*** as claimed. Notably, the Office fails to identify any teachings of Barnes which allegedly disclose or suggest the limitations of claim 124. Claim 124 is allowable over the prior art of record.

Applicant hereby adds new claims 133-136 which are supported at least by the teachings of the originally-filed application at, for example, page 6, line 22 spanning to page 9, line 13 and Fig. 1.


Applicant submits a new IDS herewith and copies of forms PTO-1449 of previously filed IDSs which each include at least one reference which has not been initialed by the Examiner. Applicant requests initialization of the forms and return of the forms to Applicant.

Applicant requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 7/16/04

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